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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/980,582	04/04/2002	Steve Vestergaard	119.5-US-WO	5988
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OYEN, WIGGS, GREEN & MUTALA LLP 480 - THE STATION 601 WEST CORDOVA STREET VANCOUVER, BC V6B 1G1 CANADA			EXAMINER TO, BAOTRAN N	
			ART UNIT	PAPER NUMBER
			2135	

DATE MAILED: 01/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/980,582

Applicant(s)

VESTERGAARD ET AL.

Examiner

Baotran N. To

Art Unit

2135

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 and 17-33 is/are pending in the application.
- 4a) Of the above claim(s) 13-16 is/are ~~withdrawn from consideration~~ canceled.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 17-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This Office action responds to the applicant's amendment filed on 11/03/2005. In this amendment, Claims 1-12 are amended, Claims 13-16 are cancelled, and new Claims 17-33 are added. Claims 1-12 and 17-33 remain for examination.

Claim Objections

2. Claims 32-33 are objected to because of the following informalities:
A method of Claims 32-33 according to the independent Claim 4 not Claim 1.
Appropriate correction is required.

Response to Arguments

3. Applicant's amendment to Claims 1-12 necessitated the new ground(s) of rejection. New grounds of rejection are presented below.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

Art Unit: 2135

only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1, 3, 17 and 21-25 are rejected under 35 U.S.C. 102(e) as being anticipated by Glover (U.S. Patent 6,052,780) herein referred to as Glover.

Regarding on Claim 1, Glover discloses a method of distributing electronic media, the method comprising:

downloading a file (computer program) (col. 4, lines 30-35), the file comprising an integral decryption engine (decryption program) and encrypted media content (encrypted digital information) (col. 3, lines 45-50 and col. 20, lines 15-35),

requesting a decryption key (key) from a remote server (content provider) (col. 3, lines 45-50, col. 21, lines 20-65 and col. 22, lines 1-10); and

responding to receipt of said decryption key from said remote server by:
decrypting said media content using said integral decryption engine and the decryption key (col. 3, lines 45-50 and col. 21, lines 45-65).

Regarding on Claim 3, Glover discloses the limitations as discussed in Claim 1 above. Glover further discloses after decrypting the media content, viewing said media content by executing external viewer software linked to said file (col. 21, lines 20-60).

Regarding on Claim 17, Glover discloses the limitations as discussed in Claim 1 above. Glover further discloses wherein the file is executable independently of other

programs and wherein requesting the decryption key and decrypting the media content are accomplished by executing the file (col. 21, lines 45-50).

Regarding on Claim 21, Glover discloses the limitations as discussed in Claim 3 above. Glover further discloses wherein decrypting the media content and viewing the media content are accomplished without storing a decrypted copy of the media content locally (col. 6, lines 55-65).

Regarding on Claim 22, Glover discloses the limitations as discussed in Claim 1 above. Glover further discloses wherein the decryption key is bonded to a computing device which requested the decryption key (col. 4, lines 15-20).

Regarding on Claim 23, Glover discloses the limitations as discussed in Claim 1 above. Glover further discloses wherein downloading the file comprises downloading the file from the remoter server (col. 21, lines 1-5).

Regarding on Claim 24, Glover discloses the limitations as discussed in Claim 1 above. Glover further discloses wherein downloading the file comprises downloading the file from a second user (col. 22, lines 10-20).

Regarding on Claim 25, Glover discloses the limitations as discussed in Claim 24 above. Glover further discloses wherein downloading the file from the second user comprises using a peer to peer network (col. 22, lines 10-20).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 4-8, 10-11 and 28-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Glover (U.S. Patent 6,052,780) herein referred to as Glover in view of Budge et al. (U.S. Patent 6,564,248 B1) herein referred to as Budge.

Regarding on Claim 4, Glover discloses a method of managing distribution of proprietary electronic media, the method comprising:

downloading a single file (computer program) (col. 4, lines 30-35), the file comprising an integral decryption engine and encrypted media content (encrypted digital information) (col. 3, lines 45-50), but Glover explicitly does not disclose "integral media playback software."

However, Budge expressly discloses integral media playback software (col. 2, lines 25-30).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated Glover's invention with Budge to provide integral media playback software. One of ordinary skill in the art would have been motivated to allow the receiving system to view the video file without necessity of previously installing special software at the receiving system (col. 6, lines 15-20).

Glover and Budge disclose the limitations of Claim 4 above. Furthermore, Glover discloses the single file executable independently of other program to:

decrypt the media content using the integral decryption engine and a decryption key obtained separately from the file (col. 3, lines 45-50 and col. 21, lines 20-65); and Budge explicitly discloses view the media content using the integral media playback software (col. 6, lines 15-20).

Regarding on Claim 5, Glover and Budge disclose the limitations as discussed in Claim 4 above. Glover further discloses wherein downloading the single file comprises downloading said single file from a remote server via a communication network (col. 21, lines 5 and col. 22, lines 15-20).

Regarding on Claim 6, Glover and Budge disclose the limitations as discussed in Claim 5 above. Glover further discloses downloading said decryption key from said remote server via said communication network (col. 21, lines 60-65 and col. 22, lines 1-10).

Regarding on Claim 7, Glover and Budge disclose the limitations as discussed in Claim 6 above. Glover further discloses requesting the decryption key from the remote server (col. 3, lines 45-50, col. 21, lines 45-65 and col. 22, lines 1-10); and

said remote server responding to said request and responding to a digital wallet having sufficient funds, by making said decryption key available for download (col. 4, lines 30-35).

Regarding on Claim 8, Glover and Budge disclose the limitations as discussed in Claim 7 above. Glover further discloses bonding the decrypting key to a computing device which requested the decrypting key (col. 4, lines 30-35).

Regarding on Claim 10, Glover and Budge disclose the limitations as discussed in Claim 8 above. Glover further discloses wherein bonding comprises communicating bonding information relating to the computing device to said remote server (col. 22, lines 5-15).

Regarding on Claim 11, Glover and Budge disclose the limitations as discussed in Claim 6 above. Glover further discloses wherein said remote server tracks a number of decrypting key downloads relating to the single file (col. 21, lines 5-10).

Regarding on Claim 28, Glover and Budge disclose discloses the limitations as discussed in Claim 4 above. Glover further discloses wherein the single file is

executable to view the media content using the integral media playback software without storing a decrypted copy of the media content locally (col. 20, lines 55-67).

Regarding on Claim 29, Glover and Budge disclose the limitations as discussed in Claim 4 above. Glover further discloses wherein downloading the single file comprises downloading the single file from a second user (col. 22, lines 10-20).

Regarding on Claim 30, Glover and Budge disclose the limitations as discussed in Claim 29 above. Glover further discloses comprising downloading the decryption key from a remote server, the remote server different than the second user (col. 21, lines 20-65 and col. 21, lines 1-20).

Regarding on Claim 31, Glover and Budge disclose the limitations as discussed in Claim 30 above. Glover further discloses wherein server tracks a number of decryption key downloads relating to the single file (col. 21, lines 5-10).

6. Claims 2, 12 and 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Glover as applied to claim 1 above, and further in view of Glover in view of Budge et al. (U.S. Patent 6,564,248 B1) herein referred to as Budge.

Regarding on Claim 2, Glover discloses the limitations as discussed in Claim 1 above. Glover further discloses after decrypting the media content (col. 3, lines 45-50),

but Glover explicitly does not disclose viewing said media content by executing viewer software, the viewer software also integral with said file.

However, Budge expressly discloses viewing said media content by executing viewer software, the viewer software also integral with said file (col. 2, lines 25-30).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated Glover's invention with Budge to provide viewing said media content by executing viewer software, the viewer software also integral with said file. One of ordinary skill in the art would have been motivated to allow the receiving system to view the video file without necessity of previously installing special software at the receiving system (col. 6, lines 15-20).

Regarding on Claim 12, Glover and Budge disclose the limitations as discussed in Claim 2 above. Glover further discloses wherein said file comprises Web links to one or more of: an artist associated with the media content, retailer associated with the media content, distributor associated with the media content and record label associated with the media content (col. 22, lines 1-20).

Regarding on Claim 18, Glover discloses the limitations as discussed in Claim 17 above. Glover does not disclose wherein the file also comprises integral media player software.

However, Budge expressly discloses wherein the file also comprises integral media player software (col. 2, lines 25-30).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated Glover's invention with Budge to provide wherein the file also comprises integral media player software. One of ordinary skill in the art would have been motivated to allow the receiving system to view the video file without necessity of previously installing special software at the receiving system (col. 6, lines 15-20).

Regarding on Claim 19, Glover discloses the limitations as discussed in Claim 18 above. Budge further discloses wherein executing the file also accomplishes execution of the integral media player software and playback of the media content (col. 2, lines 25-30).

Regarding on Claim 20, Glover and Budge disclose the limitations as discussed in Claim 2 above. Glover further discloses wherein decrypting the media content and viewing the media content are accomplished without storing a decrypted copy of the media content locally (col. 20, lines 55-67).

7. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Budge et al. (U.S. Patent 6,564,248 B1) herein referred to as Budge in view of Wiser et al. (U.S. Patent 6,385,596 B1) herein referred to as Wiser.

Regarding on Claim 9, Budge discloses a method of securely distributing media files, the method comprising:

generating an executable file (executable video files) comprising encrypted media content and integral media playback software (col. 2, lines 25-30 and col. 5, lines 5-10),

the file executable independently of other programs (col. 5, lines 25-30), but Budge explicitly does not disclose "to play only a portion of the encrypted media content, without use of decryption key."

However, Wiser clearly discloses the online music distribution system provides for previewing of audio data prior to purchase, without use of a decryption key (col. 3, lines 50-60).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated Wiser's invention with Budge to provide to play only a portion of the encrypted media content, without use of decryption key. One of ordinary skill in the art would have been motivated to allow the consumer has the opportunity to watch the portion of the video program before ordering (col. 3, lines 55-60).

8. Claims 26-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Glover as applied to claim 1 above, and further in view of Wiser et al. (U.S. Patent 6,385,596 B1) herein referred to as Wiser.

Regarding on Claims 26 and 27, Glover discloses the limitations as discussed in Claim 1 above. Glover explicitly does not disclose wherein a portion of the media content is previewable prior to decrypting the media content using the integral decryption engine and the decryption key.

However, Wiser expressly discloses a portion of the media content is previewable prior to decrypting the media content using the integral decryption engine and the decryption key (col. 3, lines 50-60).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated Wiser's invention with Spies to provide a portion of the media content is previewable prior to decrypting the media content using the integral decryption engine and the decryption key. One of ordinary skill in the art would have been motivated to allow the consumer has the opportunity to watch the portion of the video program before ordering (col. 3, lines 55-60).

9. Claims 32-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Glover and Budge as applied to claim 4 above, and further in view of Wiser et al. (U.S. Patent 6,385,596 B1) herein referred to as Wiser.

Regarding on Claims 32 and 33, Glover discloses the limitations as discussed in Claim 4 above. Glover and Budge explicitly do not disclose wherein a portion of the media content is previewable prior to decrypting the media content using the integral decryption engine and the decryption key.

However, Wiser expressly discloses a portion of the media content is previewable prior to decrypting the media content using the integral decryption engine and the decryption key (col. 3, lines 50-60).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated Wiser's invention with Glover and Budge to provide a portion of the media content is previewable prior to decrypting the media content using the integral decryption engine and the decryption key. One of ordinary skill in the art would have been motivated to allow the consumer has the opportunity to watch the portion of the video program before ordering (col. 3, lines 55-60).

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

Art Unit: 2135


the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Baotran N. To whose telephone number is 571-272-8156. The examiner can normally be reached on Monday-Friday from 8:00 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Y. Vu can be reached on 571-272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Baotran To
01/18/2006


Primary Examiner
Art Unit 2135